

REMARKS

By the present amendment, non-elected claims 1-8 have been canceled. These claims are canceled without prejudice or disclaimer and applicants reserve the right to file one or more divisional applications directed to the subject matter of these non-elected claims.

In addition, independent claims 9, 10 and 15 have been amended to obviate the examiner's objections thereto and/or to further clarify the concepts of the present invention. In particular, claims 9 and 15 have been amended to clarify the recitation as to components (B) and (C) already recited in these claims. Support for the amendment of claim 10, with regard to component (B), can be found on page 27, lines 11 to 13 and lines 19 to 21 of the subject specification. Furthermore, dependent claims 13 and 14 have been canceled and dependent claim 24 has been amended to remove an alleged informality. Entry of these amendments is respectfully requested.

In the Office Action, claims 9, 10 and 15 were objected to as containing the noted informalities. The suggestions contained in the Action have been adopted. In particular, the following is to be noted:

(i) Claim 9, part (C1), has been amended to read "potassium salt or ammonium salts" according to the requirement.

(ii) With respect to the objection raised against parts (C2) in claims 9 and 15, the objection is not understood since Markush type language does not use alternative

groups according to U.S. practice but rather uses "and" groups as in claims 9 and 15.

(iii) As described above, claim 10, last line is amended to read "potassium salt or ammonium salts" according to the requirement.

(iv) The "and" in "potassium salt and ammonium salts" in claim 15, part (C1), has been amended to read "or", as in claims 9 and 10.

Accordingly, withdrawal of the objection is requested.

Claim 24 was rejected under the second paragraph of 35 USC § 112 as being indefinite. Specifically, it was asserted that the phrase "such as" for being unclear. In response, it is to be noted that the parenthetical phrase "(such as foods, cosmetics and medicines)" has been deleted from the claim. Accordingly, withdrawal of the rejection under the second paragraph of 35 USC § 112 is respectfully requested.

Claim 13 was rejected under 35 USC § 102(b) as being anticipated by the cited patent to Taniguchi et al. In addition, claims 13, 14 and 18-24 were rejected under 35 USC § 102(b) as being anticipated by the Kobayashi et al patent. In making these two rejections, it was asserted that each patent teaches a composition containing (A) a diacetal and (B2) a C8-C32 aliphatic carboxylic acid having at least one hydroxy group per molecule. It was further asserted that these known compositions would inherently suppress odor and taste originating from the sorbitol. Reconsideration of this rejection in view of the above claim amendments and the following comments is respectfully requested.

As noted previously, claims 13 and 14 have been canceled herein. Dependent claims 18-24 no longer depend from these claims, but rather from non-rejected claims 15-17. Thus, both of the rejections of claims 13, 14 and 18-24 are now moot. Accordingly, withdrawal of the rejections under 35 USC § 102(b) and allowance of claims 18 through 24 over the cited patents are respectfully requested.

Claims 9-12 and 15-24 (a telephone call to Examiner Ronesi indicated that "24" should have been included in the statement of rejection) were rejected under 35 USC § 103(a) as being unpatentable over the same Kobayashi et al patent as cited in the previous rejection. It was asserted in making this rejection that, in addition to that as set forth above, the cited patent teaches diacetal compositions which also contain a C6 to C30 aliphatic alcohol sulfuric ester salt. Reconsideration of this rejection in view of the above claim amendments and the following comments is respectfully requested.

It is submitted that the patent to Kobayashi et al does not teach or suggest the method for suppression of aldehyde by thermal decomposition of at least one diacetal as presently claimed. More specifically, the Kobayashi et al patent discloses a granular or powdery diacetal composition, comprising a diacetal represented by the formula (1) and a binder, the binder being uniformly dispersed in the diacetal particles (Claim 1).

The following Table A provides a comparison of the presently claimed invention with that disclosed in the Kobayashi et al patent. In the Table, "X" indicates that there is no disclosures in the cited document, and "O" indicates that disclosures are found in the cited document.

Table A.

The present invention		Kobayashi
A	diacetal	O
B1	aliphatic alcohol	X
B2	aliphatic carboxylic acid having at least one OH	O
C1	anionic surfactant	O
C2	alkali metal salt of fatty acid optionally having OH	X
C3	aliphatic amine	X
C4	Mixture of at least two of (C1), (C2) and (C3)	X
Effect of the	Suppressing transfer of odor/taste, and	O

By the amendments herein, the subject claims now recite a combination of component (B) and component (C), which are not disclosed in the Kobayashi et al patent.

It was asserted in the Action that the Kobayashi et al patent discloses a powder diacetal composition for use as a nucleating agent in polyolefin resin comprising at least one dibenzylidene sorbitol and 0.2-2.5 parts pbw binder such as hydroxyl group-containing carboxylic acids (e.g. 12-hydroxystearic acid), salts (e.g. salts of a sulfuric acid ester of C₆-C₃ aliphatic alcohols), and mixture of the two.

However, according to the claim amendments herein, components (B) and (C) of independent claims 9 and 15, where claim 9 is directed to a method for suppressing aldehyde generation, and claim 15 is directed to a granular or powdery composition are

limited to the specific combination, i.e., (B1)+ {one of (C1), (C3) and (C4)}, or (B2) + {one of (C2), (C3) or (C4)}.

With regard to amended claim 9, the cited Kobayashi et al patent does not, among other things, teach (a) The combination of (B1)+{one of (C1), (C3) and (C4)}. Specifically, the Kobayashi et al patent does not teach the use of (B1) alcohols, but merely teaches the use of esters of phosphoric acid and an alcohol, esters of phosphorous acid and an alcohol, or salts of sulfuric acid ester of an alcohol, and like esters as binders (cf., column 9, line 9 to column 10, line 58 of the Kobayashi et al patent). In other words, an alcohol per se is not used in the Kobayashi et al patent, and accordingly the patent fails to teach the use of component (B1), which is an essential component in the presently claimed invention.

In addition, there is a significant difference in the intended use. The Kobayashi et al patent describes melting point depression, suppression of dust, improvements in the flow property of the powders, suppression of adhesion and the like, of diacetals (e.g., Table 2). In distinct contrast, the presently claimed invention relates to a composition used for the purpose of suppressing transfer of odor and taste attributable to the particular diacetal represented by the formula (1). The Kobayashi et al patent does not disclose such intended use which unique to the present invention.

It was asserted in the Action that the Kobayashi et al patent does disclose the use of mixture of genus embodiments of components (B) and (C), thereby motivates a skilled artisan to arrive at the present invention. However, as described above, the Kobayashi et al patent does not disclose alcohol (B1), which is an essential component of the present invention. Furthermore, the composition disclosed in the Kobayashi et al patent achieves the melting point depression, improvement of transferability, uniform dispersion (see column 2, lines 52-61 in the patent), but it does not clearly disclose the effect of the present invention, i.e., suppression of transfer of odor/taste. The combination (B1)+{one of (C1), (C3) or (C4)} according to claim 9, is characterized in that alcohol (B1) is used together with a specific component of (C), and thereby excellent suppression of transfer of odor and taste can be achieved. Therefore, even a person of ordinary skill in the art would not have easily arrived at the subject matter of claim 9 based on the disclosure of the Kobayashi et al patent, which nowhere suggests the distinctive features of the present invention nor any effects achieved by employing such features.

With regard to combination of (B2) + {one of (C2), (C3) or (C4)}, it was asserted in the Action that the Kobayashi et al patent teaches the mixture of dibenzylidene sorbitol and 12-hydroxystearic acid. However, the cited patent does not teach combining (B2) aliphatic carboxylic acid having at least one OH with (C2), (C3), or (C4). Furthermore, the Kobayashi et al patent nowhere discloses that the specific combination of (B2) + {one of (C2), (C3) or (C4)} suppresses transfer of odor/taste. Therefore, even a person of ordinary

skill in the art would not have easily arrived at the subject matter of claim 9 based on the disclosure of the Kobayashi et al patent.

Independent claim 15 is directed to a granular or powdery composition where the combination of components (B) and (C) limited in the same manner as amended claim 9, i.e., (B1)+{one of (C1), (C3) and (C4)}, or (B2) + {one of (C2), (C3) or (C4)}. The composition of Claim 15 is a composition comprising substantially the same components (A) to (C) used in the method of claim 9.

As explained above, the Kobayashi et al patent nowhere teaches or suggests the specific combination to suppress transfer of odor/taste originating from a diacetal represented by the general formula (I) (component (A)). Therefore, it is submitted that claim 15 is also unobvious over the Kobayashi et al patent.

Inasmuch as claims 10 to 12 are dependent claims on amended independent claim 9, and claims 16 to 24 are also dependent claims of independent claim 15. As explained above, claims 9 and 15 are both unobvious over the Kobayashi et al patent. Therefore, these dependent claims, claims 10 to 12, 16 to 24 are also unobvious over the cited patent as well.

For the reasons stated above, withdrawal of the rejection under 35 U.S.C. § 103(a)

and allowance of claims 9-12 and 16-24 over the cited patents are respectfully requested.

Claims 9-24 were provisionally rejected over claims 1-13 of the cited '088 patent to under the judicially created doctrine of obviousness type double patenting. In making this rejection, it was asserted that, although the claims of the subject application and the cited patent were not identical, they are obvious over the other and thus are not patentably distinct.

Accompanying this Amendment is a Terminal Disclaimer relative to the cited patent such that the patent which issues from this application is enforceable for the same period of time as the issued patent and thus there is no extension of protection for the common concept. Accordingly, withdrawal of the provisionally rejected of claims 9-24 over claims 1-13 of the cited '088 patent to under the judicially created doctrine of obviousness type double patenting.

Also, claims 9-24 were rejected under 35 USC § 103(a) as being unpatentable over the cited '088 patent. In making this rejection, it has been acknowledged that the patent constitutes prior art under 35 USC § 102(e) and thus that the rejection might be overcome by showing that the patent is disqualified under 35 USC § 103(c).

Please be advised that the '088 patent is still assigned to the subject assignee, NEW JAPAN CHEMICAL. Thus, it is submitted that the provisions of 35 USC § 103(c) are applicable since the subject application and the patent are assigned to the same assignee and the application which issued as the '088 patent and the subject application were copending.

For the reasons stated above, withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claims 9 through 24 over the cited '088 patent are respectfully requested.

In addition, it was asserted that claims 9-24 were not patentably distinct from the claims of the patent. While the precise basis for this assertion was not stated, it is noted that the examiner referred to paragraph 8 which is provisional rejection under the judicially created doctrine of obviousness type double patenting. Presumably, if the above rejection is obviated, this rejection will be overcome as well. It is submitted that reliance upon 35 USC § 103(c) as above would also be sufficient.

In view of the foregoing, it is submitted that the subject application is now in condition for allowance and early notice to that effect is earnestly solicited.

In the event this paper is not timely filed, the undersigned hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit

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Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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